

### **REMARKS**

Claims 1, 6, 11, 14-15, and 27 are amended, claim 3 is canceled, and no claims are added; as a result, claims 1-2, 4-15, 22-29, and 37-59 remain pending in this application.

#### **§112 Rejection of the Claims**

Claims 11 and 14 were rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate description or enablement. Applicant has amended claims 11 and 14. Consideration of the amendments and withdrawal of the 35 U.S.C. § 112, first paragraph rejection is respectfully requested.

#### **§102 Rejection of the Claims**

Claims 6 and 10 were rejected under 35 U.S.C. § 102(e) for anticipation by Mitra et al. (U.S. 6,167,472; hereinafter “Mitra”). Applicant respectfully traverses this rejection. Applicant respectfully submits that Mitra fails to teach or suggest the entirety of independent claim 6.

For example, Applicant is unable to locate in Mitra where a capabilities list is capable of being modified. Although Mitra at col. 2, lines 60-64 describes “configuration information typically includes . . . device capabilities”, there does not appear to be any teaching of a modification to a capabilities list that is capable of modification. Further, a modification to a capabilities list, as is possible in claim 6, modifies the capabilities a device makes available. There is no discussion in Mitra of modifying the available capabilities of a device. Applicant respectfully submits that Mitra fails to teach or suggest a capabilities list that is capable of modification.

Thus, Applicant respectfully requests withdrawal of the rejection and allowance of independent claim 6 and claim 10, which depends therefrom.

§103 Rejection of the Claims

Claims 1-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schimmel (U.S. 6,601,120; hereinafter “Schimmel”) in view of Sibigroth (U.S. 4,580,246; hereinafter “Sibigroth”).

Applicant has amended independent claim 1 to include previously pending, now canceled claim 3. Claim 1 now specifies that “each of the plurality of nodes includes a register to specify a capability of the apparatus.” Applicant is unable to identify such a teaching in either Schimmel or Sibigroth. The Office Action at numbered paragraph 14 cited Schimmel col. 7, lines 11-29 as providing such a teaching. However, Applicant cannot find such a teaching in this cited portion, or elsewhere in Schimmel or Sibigroth.

Thus, because the proposed combination Schimmel and Sibigroth fails to teach or suggest every claim limitation as required for a *prima facie* showing of obviousness, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of independent claim 1.

Claims 2 and 4-5 depend directly from allowable independent claim 1 and are allowable for at least the same reasons.

Claims 6-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Carson et al. (U.S. 5,911,051; hereinafter “Carson”) in view of Gafken (U.S. 6,026,016; hereinafter “Gafken”).

Applicant has amended independent claim 6 to specify that “a modification to the capabilities list by the low-level software modifies capabilities available from the PCI local bus compliant device.” Applicant is unable to find such a teaching in either Carson or Gafken.

Thus, Applicant requests consideration of claims 6-10 in view of the present amendment to claim 6. Applicant respectfully submits that the amendment overcomes the 35 U.S.C. § 103(a) rejection and places claims 6-10 in condition for allowance. Therefore, Applicant respectfully requests allowance of claims 6-10.

Claims 11-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Larsen et al. (U.S. 6,154,819; hereinafter “Larsen”) in view of Schimmel.

Applicant has amended independent claim 11 to specify that “the control register is writable only by a first level of software.” Applicant respectfully submits that the proposed combination of Larsen in view of Schimmel fails to teach or suggest this portion of amended independent claim 11. Applicant further submits that this amendment places claim 11 in condition for allowance.

Claims 12 and 13 depend, directly or indirectly, from independent claim 11 and are patentable for the same reason, plus the elements of the claims. For example, with regard to claim 12, the Office Action cites Schimmel, col. 7, lines 22-34 as teaching “the series of link list registers are arranged in groups, each group forming a linked list node, each link list node including one next node pointer register.” Applicant is unable to find such a teaching in the cited portion of Schimmel.

Thus, Applicant respectfully requests consideration of the amendment to independent claim 11 and allowance of claims 11-13.

Claims 14-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Riley et al. (U.S. 2002/0073258; hereinafter “Riley”) in view of Larsen et al.

Regarding the Riley reference, Applicant reserves the right to swear behind this reference at a later date.

Nevertheless, Applicant has chosen to amend independent claim 15 to specify that the “series of link list registers include data representative of one or more capabilities of a PCI compliant computer peripheral.” Applicant respectfully submits that the proposed combination of Riley in view of Larsen fails to teach or suggest a capabilities linked list capable of modification. The integrated circuit of claim 15 thus provides the ability to modify capabilities available from a PCI compliant computer peripheral. Applicant has found no such teaching or suggestion to allow such capability modifications in the cited references or elsewhere in the prior art. Thus, Applicant respectfully submits that independent claim 15 is in condition for allowance.

Claim 14 depends from allowable independent claim 15 and is allowable for the same reasons, plus the elements of the claim.

Thus, Applicant respectfully requests consideration of the amendment to and allowance of claim 15 and allowance of claim 14.

Claims 22-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schimmel in view of DeRoo et al. (U.S. 5,764,995; hereinafter “DeRoo”).

Applicant respectfully traverses the rejection of claims 22-26 because the combination of Schimmel in view of DeRoo fails to teach or suggest a writable register to point to a capabilities list. Further, neither Schimmel or DeRoo even contemplate a capabilities list.

The second writable register in claim 22 can be written to to point to a capabilities list. In various embodiments described in the application, this second register can be utilized to point to one of several possible capability lists. Thus, because the cited references fail to even contemplate a capability list, the asserted *prima facie* case of obvious is deficient.

Thus, Applicant respectfully submits that claim 22 is in condition for allowance.

Claims 23-26 depend, directly or indirectly, from independent claim 22 and are allowable for the same reasons, plus the elements of the claims.

Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of claims 22-26.

Claims 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Horan et al. (U.S. 5,999,198; hereinafter “Horan”) in view of Lin et al. (U.S. 5,765,026; hereinafter “Lin”) and DeRoo et al.

Applicant has amended independent claim 27 to specify that “the register groups can be written to modify one or more capabilities of the integrated circuit.” This amendment clarifies the novelty and unobviousness of independent claim 27. None of the cited references, Horan, Lin, or DeRoo, provides a teaching, suggestion, or motivation to allow modification of such a capability register that affect available integrated circuit capabilities. Thus, Applicant respectfully submits that amended independent claim 27 is in condition for allowance.

Claims 28 and 29 depend from allowable, amended independent claim 27 and are patentable for at least the same reasons, plus the elements of the claims.

Applicant respectfully requests consideration of the amendment to claim 27, and allowance of claims 27-29.

Claims 37-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schimmel in view of Larsen et al.

Applicant has reviewed the rejection of claims 37-41 bases on Schimmel and Larsen. However, the citation to Schimmel and Larsen appear to be interchanged or include typographical errors. As such, Applicant is not able to fully ascertain the nature of the rejection of these claims.

Nevertheless, Applicant respectfully submits that the combination of Schimmel in view of Larsen is deficient because both references fail to contemplate a capabilities linked list, or an equivalent, as is claimed. Thus, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 37-41.

Claims 42-59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schimmel in view of Gafken. Applicant respectfully traverse this rejection because the combination of Schimmel in view of Gafken fails to teach or suggest the entirety of the claims.

For example, each of the independent claims includes a portion that addresses a capability or capabilities. (e.g., claim 42 capabilities register; claim 47 list of capabilities; claim 52 capabilities linked list; and claim 56 existence of a capability.) However, neither Schimmel or Gafken even address capabilities as claimed or in the context of the application.

Thus, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of claims 42-59.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 349-9587 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

A. K. PORTERFIELD

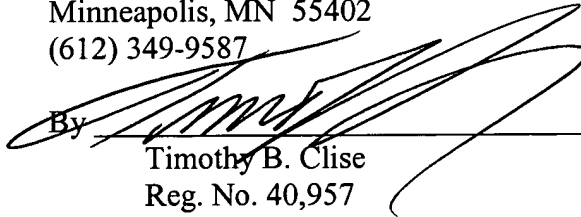
By his Representatives,

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